THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte ALEXANDER LARIVIERE

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Appeal No. 96-0324
Application 08/045,747[1]

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HEARD: June 5, 1997

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Before STONER, Chief Administrative Patent Judge, and HAIRSTON and FRANKFORT, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

[1] Application for patent filed April 8, 1993. According to appellant, the application is a continuation-in-part of Application 08/011,610, filed February 1, 1993.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 16 and 18, which are all of the claims remaining in this application. Claim 17 has been canceled.

Appellant's invention relates to an improvement in a "springer fork" for a bicycle and, more particularly, to a kit including such an improved fork which is used for safely converting a standard bicycle having a springer fork to a "low rider" style bicycle with a modified springer fork. According to appellant's specification (pages 1-2), "[m]aking a low rider involves giving the bicycle a longer and lower look" wherein it is the specially bent fork "that principally contributes the longer and lower look that defines a low rider." As noted in the paragraph bridging pages 3 and 4 of the specification one very popular type of fork for low riders is the "springer fork," which was originally made by Schwinn. It is also indicated that

> [t]o convert the springer fork to a low rider fork, the common practice is to bend the fork

> by heating it with a torch, and then send it out to be plated. The result is an unsafe fork that may collapse, a bicycle frame that is lowered to the point that the pedals may hit the ground, and a high price when the cost of bending and plating is included.

Appellant's improvement over the prior art springer fork is set forth and briefly explained in the specification at page 4, line 29 through page 5, line 14, as follows:

> In accordance with the present invention, the low rider springer fork is made by bending a 26 inch fork to make a 20 inch curved fork. The bending is done cold, that is, without heating the fork and without damaging the chrome plating. The fork is bent into a smooth curve having about a six inch bending radius. The bend is slightly less than a ninety degree bend, and is in the range of about 70 degrees to about 80 degrees.
>
> Struts that are normally a part of the springer fork are shortened to accommodate the change from a 26 inch fork to a 20 inch curved fork. This bend gives the appearance of a low rider without bringing the pedals closer to the ground. No re-chroming is necessary, and there is no buckling of metal.
>
> The low rider springer fork is used with a standard 20 inch wheel and a standard 20 inch fender. A threaded fastener is affixed to the bottom of the steer tube for fastening the fender. A long screw may be passed through a hole in the fender and into the threaded fastener in the bottom of the steer

> tube. An angulated washer may be used to accommodate the curvature of the fender to the head of the screw. A two inch section of hollow chrome tubing may be used to hide the screw threads.

Claims 1, 7 and 18 are representative of the subject matter on appeal and a copy of those claims, as reproduced from the Appendix attached to appellant's brief, is appended to this decision.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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|---|---|---|
| Clark | 1,995,796 | Mar. 26, 1935 |
| Schwinn | 2,160,034 | May 30, 1939 |
| Moulton | 3,208,767 | Sept. 28, 1965 |
| Smith | 4,037,855 | July 26, 1977 |
| Georgiev | 4,480,848 | Nov. 6, 1984 |
| Isaac | 4,565,383 | Jan. 21, 1986 |
| Fuller | 5,165,712 | Nov. 24, 1992 |

Claims 1, 2, 7 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Smith.

Claims 3 through 6 and 9 through 16 stand rejected under 35 U.S.C. § 103 as being unpatentable over Smith in view of Clark, Isaac and Fuller.

Claims 1 through 6 stand additionally rejected under 35 U.S.C. § 103 as being unpatentable over Smith in view of Georgiev, Moulton, Clark and Isaac.

Claims 7 through 16 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Smith in view of Georgiev, Moulton, Clark and Isaac as applied to claims 1-6 above, and further in view of Schwinn.

Reference is made to the examiner's answer (Paper No. 11, mailed January 24, 1995) for the examiner's complete reasoning in support of the above-noted rejections. Appellant's arguments thereagainst are found in the brief (Paper No. 10, filed November 1, 1994) and in the reply brief (Paper No. 13, filed March 23, 1995).

## OPINION

In reaching our conclusions on the issues raised in this appeal, we have carefully considered appellant's specification and claims, the applied prior art references and the respective viewpoints advanced by appellant and the examiner.

As a consequence of our review, we have made the determination that the examiner's respective rejections of claims 1 through 16 and 18 under 35 U.S.C. § 102 and § 103 will not be sustained. Our reasons follow. In addition, pursuant to our authority under 37 CFR § 1.196(b), we have also decided to enter a new rejection of appealed claims 7 and 8 under 35 U.S.C. §§ 102(b)/103 based on the Schwinn patent which is of record in the application.

Like appellant (brief, pages 6-8), in reviewing the examiner's rejection of claims 1, 2, 7 and 8 under 35 U.S.C. § 102(b) based on Smith, we note that Smith clearly does not include "tubular furcations" as required in independent claims 1 and 7. The examiner's position (answer, page 9) that "[b]ecause the disclosure of Smith is silent as to element 17, Smith is capable of having a tubular configuration," and that appellant's Jepson-format claim 1 "attests to the conventionality of tubular furcations . . ." is of no moment given that the rejection under review is based on anticipation under 35 U.S.C. § 102(b) and not obviousness under 35 U.S.C. § 103. An anticipation under 35 U.S.C. § 102(b) is established only when a single prior art reference discloses, either expressly or under principles of

inherency, each and every element of a claimed invention. See RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

As a further point, we note, as appellant has, that Smith also does not include a teaching or disclosure of the "struts" set forth in claim 1, and clearly does not have the bend that extends the furcations in a forward direction "located in the lower half of said furcations" as set forth in dependent claims 2 and 8 on appeal.

With further regard to independent claim 1, we must agree with appellant that there is no disclosure whatsoever in Smith of providing a bend in the lower limbs of the furcations of a bicycle fork that extends said furcations in a forward direction and "converts a long fork to a twenty inch fork," as set forth in the claim. Based on appellant's disclosure, it is clear that this limitation requires a long fork (i.e., a 26 inch springer fork) that is subsequently provided with a bend at a location in the lower limbs of the furcations to thereby convert

said long fork into a 20 inch curved fork that is usable on a stock 20 inch bicycle frame with 20 inch wheels on the front and rear, and which provides the illusion of a longer and lower, low-rider look, but maintains the same standard safe ground clearance of the frame and the pedals as existed before the specially bent fork was added thereto. Note particularly, page 4, lines 6-10, lines 17-19 and lines 29-30; page 5, lines 3-6; page 8, lines 15-20; and page 11, lines 10-12 of

appellant's specification. Given that there is no disclosure in Smith which addresses the structural limitation of claim 1 concerning converting a long fork to a twenty inch fork, we fail to see how Smith can be said to anticipate the invention as defined in appellant's claim 1 on appeal.

With further regard to independent claim 7, we are in agreement with appellant's argument on pages 6-7 of the brief that the term "springer fork" is a standard term in the bicycle art which would be recognized by one of ordinary skill in the art as identifying the type of fork assembly shown generally in appellant's Figure 6 and in the Schwinn patent cited and applied

by the examiner, and not as being susceptible to a broad construction that would be readable on the simple shock absorbing bicycle front end seen in Smith. Appellant's own specification (at page 3, lines 29-31) supports the argued construction of the term "springer fork" by indicating that the "springer fork" was originally made by Schwinn and that other manufacturers are presently manufacturing a replica of the Schwinn springer fork. Given the art-recognized understanding of what constitutes a "springer fork," it is clear that Smith does not teach or disclose such a structure and cannot be said to anticipate under 35 U.S.C. § 102(b) the "springer fork low rider kit" defined in appellant's claim 7 on appeal.

In accordance with the foregoing, the examiner's rejection of claims 1, 2, 7 and 8 under 35 U.S.C. § 102(b) based on Smith will not be sustained.

As for the rejection of claims 3 through 6 and 9 through 16 under 35 U.S.C. § 103 as being unpatentable over Smith in view of Clark, Isaac and Fuller, we have carefully reviewed the teachings of Clark, Isaac and Fuller, however, we find

nothing therein which can be said to provide for the deficiencies of the primary reference to Smith as noted above in our discussion of the examiner's rejection of claims 1, 2, 7 and 8. That is, even if the Smith patent were modified in the manner urged by the examiner on pages 4-5 of the examiner's answer (a) to include a dropout feature with a built-in washer and raised lips, (b) to make the fork of "high strength material," and (c) to have a threaded fastener affixed to the steer tube for fastening a fender, the result would not be the subject matter as defined in appellant's claims 1 through 6 and 7 through 16 on appeal.

Accordingly, the examiner's rejection of these claims under 35 U.S.C. § 103 will not be sustained.

Turning to the examiner's rejection of claims 1 through 6 under 35 U.S.C. § 103 based on Smith in view of Georgiev, Moulton, Clark and Isaac, and that of claims 7 through 16 and 18 based on Smith in view of Georgiev, Moulton, Clark and Isaac as applied to claims 1-6 above, and further in view of Schwinn, we do not share the examiner's view that it

would have been obvious, absent any reasonable suggestion or incentive recognized in the art, to merely provide the bicycle of Smith with wheels of different sizes and, more particularly, to provide the bicycle of Smith with 20 inch wheels. This determination stems from our earlier determination that Smith fails to teach or suggest the structural limitation of appellant's claim 1 concerning converting "a long fork to a twenty inch fork" and thereby providing the illusion of a longer and lower, low-rider look, while maintaining the same standard safe ground clearance of the frame and the pedals as existed before the specially bent fork was added thereto. None of the additionally applied references addresses or suggests such a conversion either. We also again mention the other above-noted shortcomings

of Smith with regard to the lack of "tubular furcations" and "struts" therein, which deficiencies have not been addressed by the examiner.

As for the examiner's proposal to alter the simple shock absorbing front end of the bicycle in Smith to be a

"springer fork" arrangement of the type seen in Schwinn, we share appellant's view (brief, page 32) that such a total reconstruction of the front fork assembly and steer post of Smith, along with the other modifications proposed by the examiner in her rejection, is based on the hindsight benefit provided by appellant's own application disclosure and not on any teaching, suggestion or incentive provided by the references themselves. Thus, we will not sustain the examiner's rejection of claims 1 through 6 under 35 U.S.C. § 103 based on Smith in view of Georgiev, Moulton, Clark and Isaac, or that of claims 7 through 16 and 18 under 35 U.S.C. § 103 based on Smith in view of Georgiev, Moulton, Clark and Isaac as applied to claims 1-6 above, and further in view of Schwinn.

In accordance with our authority under 37 CFR § 1.196 (b), we enter the following new rejection of claims 7 and 8 under 35 U.S.C. §§ 102(b)/103.

Claims 7 and 8 are rejected under 35 U.S.C. §§ 102(b)/103 as being anticipated by Schwinn, or in the alternative as being obvious over Schwinn when considered in light of appellant's

disclosure (pages 3-4) of the "common practice" involved in converting a springer fork to a low rider fork.

The only arguable difference between the springer fork kit for a bicycle seen in Schwinn (e.g., Figures 2 through 7) and that defined in appellant's claims 7 and 8 on appeal is the recitation that the kit is a "low rider" kit. From appellant's disclosure and the language of independent claim 7, we understand this limitation to require that the bicycle be provided with a longer and lower look, and that this appearance be the result of said lower limbs of the front fork furcations "having a bend that extends said furcations in a forward direction." In our opinion, the depiction of the bicycle in Figures 5 and 7 of Schwinn meets the broadly recited requirements of a "low rider." That is, the bicycle seen in these figures has a longer and lower look, and that appearance is at least in-part the result of said front fork furcations having a bend in the lower half of said furcations that extends said furcations in a forward direction. Thus, we consider that the fork of the Schwinn patent (e.g., Fig. 7) anticipates the broadly defined "springer fork low rider kit" of appellant's claims 7 and 8 on appeal.

Moreover, even if it were to be determined that the springer fork arrangement of Schwinn is not anticipatory of the "low rider" kit set forth in appellant's claims 7 and 8 on appeal, we consider that based on the added disclosure in appellant's specification concerning the "common practice" in the art involved in converting a springer fork to a low rider fork, it would have been obvious to one of ordinary skill in the art at the time of appellant's invention to modify the springer fork seen in the Schwinn patent to be a "low rider" style fork by additionally bending the lower furcations of the Schwinn front fork at the location of the already existing bend in the lower half of the furcations thereof. We recognize that appellant would consider this modification of the springer fork of Schwinn to be "unsafe" due to the fact that the front fork might be weakened by the heating needed to achieve the bending, but we note that, in our opinion, such a modified springer fork would nonetheless be a "low rider" springer fork as broadly recited in appellant's claims 7 and 8. In this regard, we further note that claims 7 and 8 do not specify a degree of bending, or the amount

by which the bend extends the furcations in the forward direction. Thus, even a relatively small amount of bend that gives the bicycle of Schwinn a "longer and lower look" would appear to fall within the metes and bounds of the "low rider" kit as defined in these claims on appeal.

We have considered appellant's arguments in the brief and the reply brief as they may apply to the new grounds of rejection above, however, for the reasons advanced in those new grounds of rejection we remain of the view that the claimed subject matter as set forth in claims 7 and 8 on appeal is anticipated by Schwinn, or would have been obvious to the person of ordinary skill in the art based on Schwinn and the applied acknowledged prior art teachings.

In summary, the decisions of the examiner rejecting claims 1, 2, 7 and 8 under 35 U.S.C. § 102(b) based on Smith and rejecting claims 1 through 16 and 18 under 35 U.S.C. § 103 relying on Smith as the primary reference are reversed. However, as provided for in 37 CFR § 1.196(b), a new rejection of appealed

claims 7 and 8 under 35 U.S.C. §§ 102(b)/103 has been entered by this panel of the Board.

Any request for reconsideration or modification of this decision by the Board of Patent Appeals and Interferences based upon the same record must be filed within one month from the date of the decision (37 CFR § 1.197). Should appellant elect to have further prosecution before the examiner in response to the new rejection under 37 CFR § 1.196(b) by way of amendment or showing of facts, or both, not previously of record, a shortened statutory period for making such response is hereby set to expire two months from the date of this decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED, 37 CFR 1.196(b)

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| BRUCE H. STONER, JR.<br>Chief Administrative Patent Judge | ) | |
| KENNETH W. HAIRSTON<br>Administrative Patent Judge | ) | BOARD OF PATENT APPEALS AND INTERFERENCES |

CHARLES E. FRANKFORT )
Administrative Patent Judge )

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APPENDED CLAIMS

1. An improvement in a bicycle fork having a steer tube, a spring assembly fixed to said steer tube, tubular furcations fixed to said spring assembly, said furcations having a wall thickness and having lower limbs, and struts extending away from said spring assembly, said improvement comprising:

said lower limbs of said furcations having a bend that extends said furcations in a forward direction and converts a long fork to a twenty inch fork.

7. A springer fork low rider kit for a bicycle having a frame, handlebars mounted to said frame, and having a front wheel, said low rider kit comprising:

a springer fork mounted to said handlebars and fastened to said front wheel, said fork having a steer tube, a spring assembly fixed to said steer tube, tubular furcations fixed to said spring assembly, said furcations having a wall thickness and having lower limbs;

said lower limbs of said furcations having a bend that extends said furcations in a forward direction.

18. A low-rider springer fork comprising:

a steer tube having an upper portion and a lower portion;

a spring assembly including a yoke, a generally L-shaped member having an opening through which passes the upper portion of said steer tube, a helical spring captured between said yoke and said L-shaped member, a flexible annular member, an elongated fastener extending longitudinally through said yoke, said flexible annular member and said helical spring for compressing said flexible member against said yoke;

a first furcation fastened to a first distal end of said yoke;

a second furcation fastened to a second distal end of said yoke;

a first strut fastened to said first distal end of said yoke;

a second strut fastened to said second distal end of said yoke;

a rigid attachment member securing the lower portion of said steer tube to a mid portion of said furcations;

the lower limbs of said furcations having a bend that extends said furcations in a forward direction, said bend having a bending radius of substantially six inches, said bend making an angle between said furcations and said steer tube in the range of between seventy and eighty degrees, the distal end of said struts generally coinciding with the distal end of said furcations.